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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,690	04/03/2000	Raphael Duval	PET-1638-D1	4031

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EXAMINER

KRISHNAN, GANAPATHY

ART UNIT PAPER NUMBER

1623

DATE MAILED: 06/02/2003

169

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/541,690

Applicant(s)

DUVAL ET AL.

Examiner

Ganapathy Krishnan

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,60,61,65,69-72,75 and 76 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) ____ is/are allowed.

- 6) ☒ Claim(s) 21,60,61,65,69-72,75 and 76 is/are rejected.

- 7) ☐ Claim(s) ____ is/are objected to.

- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 19.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

The request filed on January 6, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/541690 is acceptable and a CPA has been established. An action on the CPA follows.

Applicants have elected the specie shown on the attachment to Amendment E (paper #12) filed May 31, 2002 and have identified claims 21, 60, 61, 65, 69-72, 75 and 76 as reading on the elected species (Paper 19).

An office action on the merits of claims 21, 60, 61, 65, 69-72, 75 and 76 is contained herein below.

Claim Objections

Claims 21, 60, 61, 69 and 76 are objected to because of the following informalities: claim 21 depends from cancelled claim 18.

In claim 60, in the recitation "one group selected from the group formed" the term formed should be replaced with either consisting or comprising. This should also be corrected in any such occurrences.

In claims 61 and 69 a comma appears to be missing between the terms aldehyde and acid in the list of substitutions for the Ar. In claim 69, in the first structure recited, the group attached to the chiral unit on either side is not clear. The figure should be redrawn to clearly show what the attached group is.

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In claim 76 the terms “product selected from” is an improper Markush language, It should be selected from the group consisting of or comprising.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 60, 61, 65, 69-72, 75 and 76 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 depends from a cancelled claim and is not clear as to what chiral compound is meant. Without a formula or a chemical name the claim is indefinite.

In claim 60 it is not clear if the line to the left of the chiral unit is a bond connecting it to another atom or not. It is not clear what “reactive towards a hydrogen” means.

Claims 61, 65 and 69 all recite structures that have lines drawn on either side of the chiral unit. These lines appear to be dangling valences with a substituent missing. In the absence of a substituent the structures recited are indefinite. Dotted lines appear in the structure between groups and also some groups are not connected to any other group in the formula. The structure is indefinite.

In claim 65 it is not clear which structure is referred to as formula III. The claim recites that in LINK B, if K is a single bond, R is not present in LINK B. There is no R in LINK B. The formula for LINK B shows an R'. It is not clear if R and R' are the same. Clarification is needed.

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In claim 69 it is not clear what “to transform at least a portion of the alkenyl moieties” means. The claim also recites R_2 and R_3 may be identical to or different from R_1 . There is no R_1 in the structures recited. It is not clear what “silicylene” is. The claim also recites that if K is a single bond, R is not present in LINK B. In the structures shown, in the LINK B part the R is attached to a carbon. If it is not present when K is a single bond then it leaves a carbon without a valence being satisfied. Also R appears in other parts of the structure. It is not clear if all the R groups are the same. If they are the same then R not being present introduces valence problems. If they are different then a clear distinction in symbols should be used.

Claim 70 recites the term “derivative”. In the absence of a chemical name or a structure the claim is rendered indefinite. The recitation “said groups also comprising a function of the type $-SH$, $-SiH$ or $-CH=CH-$ by forming covalent chemical bonds using at least part of the alkenyl moieties” is not clear. The recitation “said groups also comprising” is confusing. It is not clear which groups the terms “said groups” refers to. The whole claim is very confusing. It is not clear what is being claimed.

Claim 71 recites “at least one chiral compound according to claim 61”. Claim 61 shows two chiral units in the structure recited. It is not clear if compound refers to the chiral unit shown in the structure in claim 61. If it is not then the claim is unclear as to what compound refers to.

Claim 75 recites “ $-COCl$ or its precursor; $-COOH$,”. Since $-COOH$ is the precursor to $-COCl$ it is not clear if any precursor other than a $-COOH$ is meant by the recitation. If not then the claim should be restated to clearly convey what is meant. It is not clear how Q is attached if it is $-N=C=O$ or $-N=C=S$. Valence appears to be a problem in the manner in which the attachment of Q is shown.

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In claim 76 it is not clear what "said chiral unit of a product is a glycosidic unit of a product" means. The recitation is confusing. Clarification is needed as to what is meant by "heteroholides" and the other osides recited.

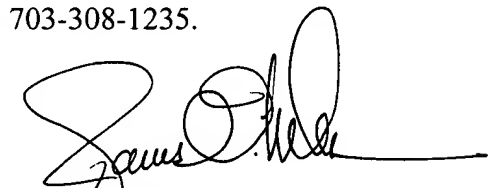
Claims that are dependent on rejected base claims which are indefinite are also rendered indefinite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 703-305-4837. The examiner can normally be reached on 8.30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

GK
May 30, 2003



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600